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10/563,258	01/04/2006	Takeshi Iwatsu	277188US6PCT	9948
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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER HOANG, SON T	
			ART UNIT 2169	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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## Office Action Summary

Application No.

10/563,258

Applicant(s)

IWATSU ET AL.

Examiner

Son T. Hoang

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2169

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 January 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>01 May 2006</u> .   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

The instant application having Application No. 10/563,258 has a total of 23 claims pending in the application; there are 3 independent claims and 20 dependent claims, all of which are ready for examination by the Examiner.

#### ***Oath/Declaration***

1. The Applicant's oath/declaration has been reviewed by the Examiner and is found to conform to the requirements prescribed in **37 C.F.R. 1.63**.

#### ***Information Disclosure Statement***

2. As required by **M.P.E.P. 609(C)**, the Applicant's submission of the Information Disclosure Statement dated May 01, 2006 is acknowledged by the Examiner. Only the cited references have been considered in the examination of the claims now pending but not the related applications since they were all filed after the earliest filing date of this instant application. As required by **M.P.E.P 609 C(2)**, a copy of the PTOL-1449 initialed and dated by the Examiner is attached to the instant office action.

#### ***Priority***

3. The Applicant's claim for foreign priority of Japanese Application No. 2003-332566 (filed on September 24, 2003) is confirmed. The Examiner takes the foreign filing date of September 24, 2003 into consideration.

#### ***Abstract***

4. The abstract of the disclosure is accepted for examination purposes.

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***Drawings***

5. The drawings were received on April 01, 2006. These drawings are acceptable for the examination purposes.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. **Claims 4-6, 13-15, 22** are rejected under 35 U.S.C. 112, first paragraph, because these claims contain the word "*unconditionally*" that are not supported in the disclosure.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. **Claims 4-6, 13-15, 22** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding **claims 4-6, 13-15, 22**; the word "*unconditionally*" is cited on line 2 without definition(s) or explanation(s) or efficient support(s) in the disclosure.

***Claim Rejections - 35 USC § 101***

10. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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**11. Claims 19-23** are rejected under 35 U.S.C. 101 as being directed to non-statutory subject matters.

Regarding **claim 19**, “a data storage control program for causing an information processing apparatus” is being recited. However, “a data storage control program” can easily be interpreted by a person with ordinary skills in the art as software per se and functional descriptive material consisting of data structures and computer programs, which impart functionality when employed as a computer component. As such, the claims are not limited to statutory subject matter and are therefore non-statutory.

Regarding **claims 20-23**, they fail to resolve the deficiencies of **claim 19** and only further limit the scope of **claims 19**. Therefore, **claims 20-23** are also rejected under 35 U.S.C. 101.

The claims above lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 U.S.C. 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se*.

Descriptive material can be characterized as either “functional descriptive material” or “nonfunctional descriptive material.” Both types of “descriptive material” are nonstatutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional

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descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994)

Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because "[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.")

### ***Claim Rejections - 35 USC § 102***

12. The following is a quotation of the appropriate Paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this Section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

13. **Claims 1-6; 10-15; 19-22;** are rejected under 35 U.S.C. 102(a) as being anticipated by Yuji (Pub. No. JP 2003-173278, published on June 20, 2003).

Regarding **claim 1**, Yuji clearly shows and discloses a data storage control apparatus ([0018]-[0022]), comprising:

data attribution detection means for detecting attribution of storing-target data (*The data is passed to the filer section. Out of the passed data, the filer section identifies expiration date information, significance information and classification information, [0022]*);

determination means for determining whether or not the storage of said data is to be performed based on the attribution of said data detected by said data attribution detection means (*When having passed over the expiration date, (Y) cancels received data (it does not record) and is completed, [0022]*);

data deletion means for deleting data having higher deletion-target priority than others from among a plurality of stored data, if said determination means determines that the storage of said data is to be performed and a storage medium for storing said data runs out of space, said deletion-target priority being determined based on attribution of said plurality of stored data (*The record control section records the information received from the filter section on a recording device. Here, when the capacity of a recording device is full, the data considered to be the most unnecessary are eliminated in order, judging from significance, classification, information, an expiration date ... Moreover, the record control section eliminates automatically the information which has passed over the expiration date in the recorded information, [0019]*); and

data storage means for storing said storing-target data in said storage medium after said data deletion means deletes data having higher said deletion-target priority (*When the capacity of a recording device is full, the data considered to be the most unnecessary are eliminated in order, judging from significance, classification information, an expiration date, etc., and the information received newly is recorded, [0019]*).

Regarding **claim 2**, Yuji further discloses a data storage control apparatus, wherein said data attribution detection means detects attribution of said data based on applications which request the storage of said data (*A sending set transmits the data of a gestalt which the inverter changed and which can be distributed with a broadcasting mold, [0018]*).

Regarding **claim 3**, Yuji further discloses a data storage control apparatus, wherein said data attribution detection means extracts data attribution information which said data contains to detect attribution of said data (*The data is passed to the filer section. Out of the passed data, the filer section identifies expiration date information, significance information and classification information, [0022]*).

Regarding **claims 4 and 6**, Yuji further discloses a data storage control apparatus, wherein the determination means unconditionally determines the storage of said data is to be performed, if attribution of said data shows that said data is information relating to broadcast contents or



said data is broadcast content data (*When it is judged that earthquake information, a heavy rain warning, etc. are important for a user as for the classification information which shows the classification of the contents whose information the and it will change into the data of a gestalt which can be distributed, [0018]. Since the information which can judge when informational important point or needlessness data are received, hence, does not record unnecessary information, [0029]).*

Regarding **claim 5**, Yuji further discloses a data storage control apparatus, wherein the determination means unconditionally determines the storage of said data is to be performed, if attribution of said data shows that said data is now-on-air information including title information of broadcast contents (*Classification information of the important information, i.e., earthquake information, a heavy rain warning etc. may be added with the category information which subdivided an informational classification further, [0018]. It is inherent that classification and/or category information contains title of the important news / information).*

Regarding **claim 10**, Yuji clearly shows and discloses a data storage control method ([0018]-[0022]), comprising the steps of:

a data attribution detection step of detecting attribution of storing-target data (*The data is passed to the filer section. Out of the passed data, the filer section identifies expiration date*

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*information, significance information and classification information, [0022]);*

a determination step of determining whether or not the storage of said data is to be performed based on the attribution of said data detected by said data attribution detection step (*When having passed over the expiration date, (Y) cancels received data (it does not record) and is completed, [0022]);*

a data deletion step of deleting data having higher deletion-target priority than others from among a plurality of stored data, if said determination step determines that the storage of said data is to be performed and a storage medium for storing said data runs out of space, said deletion-target priority being determined based on attribution of said plurality of stored data (*The record control section records the information received from the filter section on a recording device. Here, when the capacity of a recording device is full, the data considered to be the most unnecessary are eliminated in order, judging from significance, classification, information, an expiration date ... Moreover, the record control section eliminates automatically the information which has passed over the expiration date in the recorded information, [0019]);* and

a data storage step of storing said storing-target data in said storage medium after said data deletion step deletes data having

higher said deletion-target priority (*When the capacity of a recording device is full, the data considered to be the most unnecessary are eliminated in order, judging from significance, classification information, an expiration date, etc., and the information received newly is recorded, [0019]*).

Regarding **claim 11**, Yuji further discloses a data storage control method, wherein attribution of said data is detected based on applications which request the storage of said data, at said data attribution detection step (*A sending set transmits the data of a gestalt which the inverter changed and which can be distributed with a broadcasting mold, [0018]*).

Regarding **claim 12**, Yuji further discloses a data storage control method, wherein attribution of said data is detected by extracting data attribution information which said data contains, at said data attribution detection step (*The data is passed to the filer section. Out of the passed data, the filer section identifies expiration date information, significance information and classification information, [0022]*).

Regarding **claims 13 and 15**, Yuji further discloses a data storage control method, wherein it is unconditionally determined that the storage of said data is to be performed, if attribution of said data shows that said data is information relating to broadcast contents or said data is broadcast content data, at said determination step (*When it is judged that earthquake information, a heavy rain warning, etc. are important for a user*

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*as for the classification information which shows the classification of the contents whose information the and it will change into the data of a gestalt which can be distributed, [0018]. Since the information which can judge when informational important point or needlessness data are received, hence, does not record unnecessary information, [0029]).*

Regarding **claim 14**, Yuji further discloses a data storage control method, wherein it is unconditionally determined that the storage of said data is to be performed, if attribution of said data shows that said data is now-on-air information including title information of broadcast contents, at said determination step (*Classification information of the important information, i.e., earthquake information, a heavy rain warning etc. may be added with the category information which subdivided an informational classification further, [0018]. It is inherent that classification and/or category information contains title of the important news / information*).

Regarding **claim 19**, Yuji clearly shows and discloses a data storage control program ([0018]-[0022]), for causing an information processing apparatus to execute the steps of:

a data attribution detection step of detecting attribution of storing-target data (*The data is passed to the filer section. Out of the passed data, the filer section identifies expiration date information, significance information and classification information, [0022]);*

a determination step of determining whether or not the storage of said data is to be performed based on the attribution of said data detected by said data attribution detection step (*When having passed over the expiration date, (Y) cancels received data (it does not record) and is completed, [0022]*);

a data deletion step of deleting data having higher deletion-target priority than others from among a plurality of stored data, if said determination step determines that the storage of said data is to be performed and a storage medium for storing said data runs out of space, said deletion-target priority being determined based on attribution of said plurality of stored data (*The record control section records the information received from the filter section on a recording device. Here, when the capacity of a recording device is full, the data considered to be the most unnecessary are eliminated in order, judging from significance, classification, information, an expiration date ... Moreover, the record control section eliminates automatically the information which has passed over the expiration date in the recorded information, [0019]*); and

a data storage step of storing said storing-target data in said storage medium after said data deletion step deletes data having higher said deletion-target priority (*When the capacity of a recording device is full, the data considered to be the most*

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*unnecessary are eliminated in order, judging from significance, classification information, an expiration date, etc., and the information received newly is recorded, [0019]).*

Regarding **claim 20**, Yuji further discloses a data storage control program, wherein attribution of said data is detected based on applications which request the storage of said data, at said data attribution detection step (*A sending set transmits the data of a gestalt which the inverter changed and which can be distributed with a broadcasting mold, [0018]).*

Regarding **claim 21**, Yuji further discloses a data storage control program, wherein attribution of said data is detected by extracting data attribution information which said data contains, at said data attribution detection step (*The data is passed to the filer section. Out of the passed data, the filer section identifies expiration date information, significance information and classification information, [0022]).*

Regarding **claim 22**, Yuji further discloses a data storage control program, wherein it is unconditionally determined that the storage of said data is to be performed, if attribution of said data shows that said data is related information relating to broadcast contents, at said determination step (*When it is judged that earthquake information, a heavy rain warning, etc. are important for a user as for the classification information which shows the classification of the contents whose information the and it will change into the data of a gestalt which can be distributed, [0018]. Since*

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*the information which can judge when informational important point or needlessness data are received, hence, does not record unnecessary information, [0029]).*

***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title; if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

16. **Claims 7-9; 16-18; 23;** are rejected under 35 U.S.C. 103(a) as being unpatentable over Yuji (Pub. No. JP 2003-173278, published on June 20, 2003) in view of Wright, JR. et al. (Pub. No. US 2004/0122873, filed on December 20, 2002; hereinafter Wright JR.).

Regarding **claims 7-8**, Yuji does not explicitly disclose if attribution of said data shows that said data is information relating to storage media / compact discs, said data deletion means determines that said deletion-target priority of said data is high to delete said data.

Wright, JR. discloses a file can have an attribute indicating the file is deletable associated with it. The attribute is indicative that the file is deletable to software, such as operating system software; or file system software or to a user, such as a system administrator, that the file is deletable. Wright, JR. further discloses that a file can include any collection of data that is treated by a system accessing the data as a unit capable of being input and output. Therefore, a file can include any directory entry, including a single file name, a group of file names, a sub-directory, a directory or other set or subset of data units ([0025]).

It would have been obvious to a person with ordinary skills in the art at the time of the invention to incorporate the teachings of Wright, JR. with the teachings of Yuji for the purpose of facilitating management of free file space ([0006] of Wright, JR.).

Regarding **claim 9**, Wright, JR. further discloses if attribution of said data shows that said data is content data copied from storage media, said data deletion means determines that said deletion-target priority of said data is high to delete said data (*A file can include any collection of data that is treated by a system accessing the data as a unit capable of*



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*being input and output as well as associating an attribute to indicate that the file is deletable, [0025]).*

Regarding **claims 16-17, 23**; Yuji does not explicitly disclose if attribution of said data shows that said data is information relating/corresponding to storage media/compact discs, it is determined that said deletion-target priority of said data is high to delete said data, at said data deletion step.

Wright, JR. discloses a file can have an attribute indicating the file is deletable associated with it. The attribute is indicative that the file is deletable to software, such as operating system software; or file system software or to a user, such as a system administrator, that the file is deletable. Wright, JR. further discloses that a file can include any collection of data that is treated by a system accessing the data as a unit capable of being input and output. Therefore, a file can include any directory entry, including a single file name, a group of file names, a sub-directory, a directory or other set or subset of data units ([0025]).

It would have been obvious to a person with ordinary skills in the art at the time of the invention to incorporate the teachings of Wright, JR. with the teachings of Yuji for the purpose of facilitating management of free file space ([0006] of Wright, JR.).

Regarding **claim 18**, Wright, JR. further discloses if attribution of said data shows that said data is content data copied from storage media,

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it is determined that said deletion-target priority of said data is high to delete said data, at said data deletion step (*A file can include any collection of data that is treated by a system accessing the data as a unit capable of being input and output as well as associating an attribute to indicate that the file is deletable, [0025]*).

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**Conclusion**

17. These following prior arts made of record and not relied upon are considered pertinent to Applicant's disclosure:

Furuya (Pat. No. US 6,628,936) teaches communication terminal device.

Borland (Pat. No. US 6,320,943) teaches electronic directory system and method.

Sato et al. (Pat. No. US 7,103,369) teaches system and method for obtaining content relating to a predicted location of a terminal apparatus.

The Examiner requests, in response to this Office action, support(s) must be shown for language added to any original claims on amendment and any new claims. That is, indicate support for newly added claim language by specifically pointing to page(s) and line no(s) in the specification and/or drawing figure(s). This will assist the Examiner in prosecuting the application.

When responding to this office action, Applicant is advised to clearly point out the patentable novelty which he or she thinks the claims present, in view of the state of the art disclosed by the references cited or the objections made. He or she must also show how the amendments avoid such references or objections See 37 CFR 1.111(c).


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**Contact Information**

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Son T. Hoang whose telephone number is (571) 270-1752. The Examiner can normally be reached on Monday - Friday (7:30 AM – 5:00 PM).

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mohammad Ali can be reached on (571) 272-4105. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



MOHAMMAD ALI  
PRIMARY EXAMINER

/S.H./

Son T. Hoang  
Patent Examiner  
August 31, 2007